

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

(Attorney Docket No. 14364US15)

In the Application of:

Joseph J. Kubler

Serial No.: 10/783,873

Filed: February 20, 2004

For: HIERARCHICAL DATA
COLLECTION NETWORK SUPPORTING
PACKETIZED VOICE
COMMUNICATIONS AMONG WIRELESS
TERMINALS AND TELEPHONES

Examiner: Venkatesh N. Haliyur

Group Art Unit: 2476

Confirmation No.: 7542

/Kevin E. Borg/

Transmitted via the Office electronic filing
system December 29, 2010.

**APPLICATION FOR RECONSIDERATION OF THE
DETERMINATION OF PATENT TERM ADJUSTMENT
UNDER 35 U.S.C. 154(b)
ACCOMPANYING THE NOTICE OF ALLOWANCE
(37 CFR § 1.705)**

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Sir:

The Applicant respectfully requests reconsideration of the Determination of Patent Term Adjustment Under 35 U.S.C. 154(b) (PTOL-85) accompanying the Notice of Allowance mailed November 23, 2010 ("the Decision"), to the extent indicated in the following discussion and the enclosed modified version of the USPTO Patent Term Adjustment calculation on PAIR. This application for reconsideration of the Decision is being filed after the date of mailing of the Notice of Allowance and no later than the payment of the issue fee.

This application for reconsideration of the Decision is accompanied by the fee set forth in § 1.18(e) (\$200).

This application for reconsideration of the Decision includes below a statement of the facts involved in sufficient detail to allow the United States

Patent and Trademark Office (USPTO) to reach the correct patent term adjustment respecting the disputed items.

The Applicant's calculation shows that the correct patent term adjustment should be 2199 days.

The bases under § 1.702 for the adjustment are as follows.

Positive Patent Term Adjustment

Three Year Guarantee (35 USC § 154(b)(1)(B))

The USPTO calculation of the patent term adjustment under the three-year deadline for issuing a patent after its filing date was 0 days. The Applicant disagrees with this determination because the patent term adjustment on this ground should instead be 1561 days, minus 0 days consumed by an appeal, for a net adjustment of 1561 days.

Specifically, the enclosed modified version of the USPTO Patent Term Adjustment calculation on PAIR shows that:

- the actual filing date of the application was February 20, 2004,
- the third anniversary of the actual filing date was February 20, 2007,
- the USPTO projected in the DETERMINATION OF PATENT TERM ADJUSTMENT UNDER 35 USC 154(b) that the patent will issue on the first Tuesday preceding the 28th week after November 23, 2010 (the mailing date of the Determination of Patent Term Adjustment under 35 USC 154(b)), which results in a predicted patent issue date of May 31, 2011,
- the predicted patent issue date stated in the last point will be 1561 days after the third anniversary of the actual filing date, which is the appropriate patent term adjustment.

Reductions in Patent Term Adjustment

Removing Overlap

- Two or more grounds of delay overlap from February 20, 2007, to March 14, 2008, totaling 388 days of delay.
- Two or more grounds of delay overlap from October 16, 2008, to October 20, 2008, totaling 4 days of delay.
- Two or more grounds of delay overlap from November 14, 2009, to November 25, 2009, totaling 11 days of delay.

This overlap has been subtracted from the patent term adjustment in the enclosed modified version of the USPTO Patent Term Adjustment calculation on PAIR.

Three Months to Respond to Office actions (37 CFR § 1.704(b))

The applicant is contesting the following application(s) of 37 CFR § 1.704(b) to reduce the patent term adjustment in the present application.

Period from June 14, 2008, to June 16, 2008

- The pertinent Office action was mailed on March 14, 2008,
- The date three months after the mailing date of the Office action is Saturday, June 14, 2008,
- The response to the Office action was filed on Monday, June 16, 2008,
- The reduction in the patent term adjustment proposed by the USPTO is 2 days,
- The Applicant's position is that the present Office action response filed on the first business day after a deadline falling on a weekend or holiday is not late, establishing the correct reduction in patent term adjustment is 0 days.

The Applicant relies primarily on 37 CFR § 1.7(a), which states in relevant part: “When the day, or the last day fixed by statute or by or under this part for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or on a Federal holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding business day which is not a Saturday, Sunday, or a Federal holiday.” Further, the statute corresponding to 37 CFR § 1.7(a), 35 U.S.C. § 21(b), states,

When the day, or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or a Federal holiday within the District of Columbia, the action may be taken, or fee paid, on the next succeeding secular or business day.

37 CFR § 1.7(a) and 35 U.S.C. § 21(b) are applicable to the present facts because the last day set by statute (35 USC § 154(b)(2)(C)(ii)) for taking the action of filing a response to an Office action without being “deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application,” falls on a Saturday, Sunday, or on a Federal holiday within the District of Columbia. See also 37 CFR § 1.6(a)(1), which states in relevant part, “The Patent and Trademark Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia....”

Based on experience with other patent term adjustment calculations, the applicant understands the USPTO’s position on this point to be that 35 U.S.C. 154(b)(2)(C)(ii) does not require that a reply be filed in the Office within its three month grace period, but simply specifies that there is a patent term adjustment reduction if a reply is not filed within this three month period. Therefore, the “carry-over” provision of 35 U.S.C. § 21(b) does not apply to the three month period in 35 U.S.C. 154(b)(2)(C)(ii).

First, the Applicant respectfully submits that the USPTO argument interprets “the last day [] for taking any action” under 35 U.S.C. § 21(b)

inconsistently when determining the timeliness of the Office action response respecting the need for

- a PTA reduction, versus
- a fee and petition for extension of time for response outside the shortened statutory period for response.

In the case of assessing a PTA reduction, the USPTO argued in the other application that:

However, Applicant will note that 35 U.S.C. 154(b)(2)(C)(ii) [footnote omitted] does not require that a reply be filed in the Office within its three (3) month grace period, but simply specifies that there is a patent term adjustment reduction if a reply is not filed within this three (3) month period. Therefore, the “carry-over” provisions of 35 U.S.C. § 21(b) [footnote omitted] does not apply to the three (3) month period in 35 U.S.C. 154(b)(2)(C)(ii).

Since the reply is not “required” within three months, the USPTO held that 35 U.S.C. § 21(b) does not apply to make a response nominally due on Saturday timely on Monday.

But the USPTO reasons differently when determining whether a fee and petition for extension of time are owed for a response outside the shortened statutory period for response and short of the six-month absolute statutory deadline. For example, consider the 3-month shortened statutory period for response to an Office action. In that case, the USPTO “does not require that a reply be filed in the Office within its three (3) month grace period, but simply specifies that there is a [petition and fee for extension of time required] if a reply is not filed within this three (3) month period.” Yet, when the Office action responses at issue are nominally due on Saturday but filed on Monday, in accordance with USPTO rules and policy, no petition or fee for extension of time is required. The deadline is carried over, by operation of 35 U.S.C. § 21(b), to the following business day.

The extension of time situation and the PTA reduction situation are exactly analogous, for purposes of the USPTO’s argument: A response within three

months is not required, although a response filed more than three months later results in a penalty. If a response is nominally due on Saturday, but filed the following Monday, no petition and fee for extension of time is required. Yet, in the same situation respecting the same Office action, a PTA reduction is assessed. To be consistent, however, the “last day [] for taking [] action” under 35 U.S.C. § 21(b) must be Saturday in each case, and carry over to Monday in each case.

The same reasoning applies to the deadlines for paying maintenance fees. The last day for paying the first maintenance fee without penalty is 3 ½ years after the patent issues. A fee can be paid later, up to four years after the patent issues, but a penalty is assessed for late payment. Yet, if the 3 ½ year deadline falls on a weekend or holiday, the payment is timely, and no fee is assessed, on the next business day.

In short, the USPTO applies the saving provision of 35 U.S.C. § 21(b) to other due dates that are not the final deadline for response, and does not apply the penalty for filing late when the nominal deadline is on a weekend or holiday and the response is filed on the next business day. Thus, to be consistent, and to correctly interpret 35 U.S.C. § 21(b), the same provision must be applied to the three-month due date for filing a response without losing days of PTA.

Second, the USPTO cannot reasonably take the position that the Applicant unreasonably delayed prosecution of the application by waiting from a weekend or holiday, when the USPTO is closed for business, until the next day when the USPTO is open for business, to file a response. Rule 1.6(a)(1) plainly states: “The Patent and Trademark Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia.” It is plainly inconsistent with this rule to require the Applicant to file correspondence on a Saturday to avoid losing part of the term of the patent.

Finally, there are at least two important policy reasons for allowing a response due on a Saturday, Sunday, or holiday to be filed on the next business day without finding an unreasonable delay of prosecution. One reason is that the

USPTO examining staff is not required to go to work and is almost entirely absent on those days, so it would be an empty gesture to require papers to be filed a Saturday, Sunday, or holiday, rarely to be read until the next business day. No delay of prosecution results. A second reason is that it is entirely reasonable for the Applicant to do no work and attend to his or her personal and family life on weekends, not an “unreasonable delay of prosecution.” Those are the reasons why 35 U.S.C. § 21(b) was enacted, allowing that which is due on a Saturday, Sunday, or holiday to be filed on the next business day without a penalty. PTA is not really a different case, so it should be treated the same as extensions of time or the maintenance fee grace period.

Net Patent Term Adjustment

The changes requested by the Applicant to the USPTO patent term adjustment determination in the Decision are as follows:

Positive Patent Term Adjustment

- **Three Year Guarantee
(35 USC § 154(b)(1)(B))**

	Patent Term Adjustment (days)
USPTO Calculation	0
Applicant Calculation	1561

Reductions in Patent Term Adjustment

- **Removing Overlap**

	Patent Term Adjustment (days)
USPTO Calculation	0

Applicant Calculation	403
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- **Three Months to Respond to Office actions
(37 CFR § 1.704(b))**

	Patent Term Adjustment (days)
USPTO Calculation	2
Applicant Calculation	0

Conclusion

The Applicant requests modification of the patent term adjustment as indicated above. As shown in the enclosed modified version of the USPTO Patent Term Adjustment calculation on PAIR, the patent term adjustment proposed by the Applicant is thus 2199 days.

Please charge any fees or credit any overpayment of fees presently required to McAndrews, Held & Malloy, Ltd., Deposit Account No. 13-0017.

Respectfully submitted,

McANDREWS, HELD & MALLOY, LTD.

Date: December 29, 2010

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